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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

020431.0776

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on

9/18/06

Signature

Typed or printed name Steven J. Laureanti

Application Number

09/972,127

Filed

4 October 2001

First Named Inventor

Sanjay Kumar, et al.

Art Unit

3627

Examiner

Gerald J. O'Connor

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

50,274

Registration number

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

Signature
Steven J. Laureanti

Typed or printed name

817-447-9955

Telephone number

9/18/06

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 020431.0776

In re Application of:

SANJAY KUMAR, ET AL.

Serial No. 09/972,127

Filed: 4 OCTOBER 2001

For: **COLLABORATIVE FULFILLMENT
IN A DISTRIBUTED SUPPLY CHAIN
ENVIRONMENT**

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Examiner:

GERALD J. O'CONNOR

Art Unit: 3627

Confirmation No.: 3685

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP: AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir/Madam:


This Request is filed in support of the Pre-Appeal Brief Request for Review filed concurrently herewith and filed concurrently herewith a Notice of Appeal in compliance with 37 C.F.R. § 41.31 and with the rules set forth in the OG of 12 July 2005 for the New Appeal Brief Conference Pilot Program.

No amendments are being filed with this Request. If an extension of time is necessary for allowing this Request to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8(a)

Date of Deposit: 9/18/06

I hereby certify that this paper or fee is being deposited with the United States Postal Service as First Class Mail with sufficient postage under 37 C.F.R. § 1.8(a) on the date indicated above and is addressed to Mail Stop: AF, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

By: 

REMARKS

Claims 1-13 and 27-33 are currently pending in the subject Application. Claims 14-26 have been previously canceled without prejudice. Claims 1-13 and 27-33 stand rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 5,758,327 to Gardner et al. (“*Gardner*”).

Appellants hereby request a Pre-Appeal Brief Review (hereinafter “Review”) by the Pre-Appeal Brief Conference Panel (hereinafter the “Panel”) of Claims 1-13 and 27-33 finally rejected in the Final Office Action mailed 21 June 2006. This Request is provided herewith in accordance with the rules set forth in the OG of 12 July 2005. The Review is requested because the final rejection of Claims 1-13 and 27-33 is clearly improper and is based on errors in fact and is without basis, at least for the reasons set forth herein.

I. FINAL REJECTION, PREMATURE:

Appellants respectfully submit that the finality of the Final Office Action mailed 21 June 2006 is clearly improper and without basis. In response to a Final Office Action dated 22 December 2005, Appellants submitted a Response on 21 March 2006, including a Request for Continuation to allow for the entry of the Response. In the Response filed on 21 March 2006, Appellants amended independent Claims 1 and 27-29 and added new Claims 30-33 in order to more particularly point out and distinctly claim Appellants invention. Appellants respectfully submit that new Claims 30-33 raise new issues that require further consideration and/or search by the Examiner. However, although the Examiner acknowledges the addition of new Claims 30-33 in the Preliminary Remarks section of the Office Action mailed 21 June 2006. *The Office Action fails to object or reject the new issues raised in new Claims 30-33, with regards to Gardner, or any prior art.* Accordingly, the finality of the Final Office Action mailed 21 June 2006 is clearly improper and without basis and should be withdrawn. (see MPEP § 706.07(c), (d), and (e)). Therefore, Appellants respectfully request that the Panel withdraw the rejections and that Claims 1-13 and 27-33 be allowed.

II. CLEAR DEFICIENCY IN THE EXAMINER’S ARGUMENT:

Appellants respectfully submit that the rejections of record in the subject Application are clearly not proper and without basis. For example, the Examiner asserts that if “the references [*Gardner*] applied to the [35 U.S.C. § 102] rejection fail to use the same names for certain elements as the names used by Appellant, the argument is *irrelevant*”. (21 June 2006 Final Office Action, Page 8). (Emphasis Added). *Appellants respectfully disagree and further respectfully request the Examiner or the Panel to cite a specific rule in 37 C.F.R. or in the MPEP that specifically states that Appellants arguments are “irrelevant”, if the references applied to a 35 U.S.C. § 102 rejection fail to use the same names for certain elements as the names used by*

the Appellant. Appellants respectfully submit that the Examiner's "*irrelevant*" argument is *a clear deficiency in the purported prima facie case of anticipation in support of the Examiner's rejection*.

In support of the Examiner's above allegations, the Examiner cites, *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990), as holding that a reference "need not be in the identical words as used in the claims in order to be anticipatory." (21 June 2006 Final Office Action, Page 8). Appellants respectfully disagree and further respectfully submit that *In re Bond does not hold the alleged holding as asserted by the Examiner* and even if it does, which it does not, the facts in *In re Bond* are clearly distinguishable.

Appellants respectfully direct the Panel's attention to the pertinent parts of *In re Bond* regarding the 35 U.S.C. § 102 anticipation rejection:

For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference. *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988). These elements must be arranged as in the claim under review, *Lindemann Maschinenfabrik v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

In *In re Bond*, the court vacated the United States Patent and Trademark Office Board of Patent Appeals and Interferences (hereinafter "Board's") anticipation rejection and stated that the anticipation of Appellants claim was deficient. In *In re Bond*, the patent application was directed to the remote turn-on feature of a telephone answering machine. In *In re Bond*, Claim 1 provided for *inter alia*, a combination of control means, first circuit means, second circuit means, and delay means. In *In re Bond*, the Examiner rejected Claim 1 under 35 U.S.C. § 102 over U.S. Patent No. 3,723,656 to Curtis, et al. (hereinafter "*Curtis*"). However, in *In re Bond* Claim 1 was a means-plus-function claim of which the court articulated:

While a "means-plus-function" limitation may appear to include all means capable of achieving the desired function, the statute requires that it be "construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." 35 U.S.C. § 112 paragraph 6.

The court, in *In re Bond* reasoned that the "Board made no finding that the delay means of Claim 1 and that embodied in the *Curtis* device [were] structurally equivalent." The court in *In re Bond* held that the Board's "decision as to *the anticipation of Claim 1 [was] deficient and must be vacated.*" In addition, the in *In re Bond* court also reversed the Board's holding regarding the obviousness rejection.

Like the *In re Bond* case, where the court stated that in order for "a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference". Appellants respectfully submit that the Examiner has mischaracterized the *In re Bond* holding including the Examiner's assertion that a reference "need not be in the identical words as used in the claims in order to be anticipatory". (21 June 2006 Final Office Action, Page 8). Furthermore, unlike the *In re Bond*

case, where the 35 U.S.C. § 102 rejection was based on the means-plus-function language of Claim 1, the Examiner, in the subject Application has not objected or rejected any claim under 35 U.S.C. § 112 paragraph 6.

Appellants respectfully submit that Appellants do not understand the Examiner's "**irrelevant**" argument or the Examiner's use of the *In re Bond* case with respect to the subject Application. Accordingly, Appellants respectfully request that the Panel find that the Examiner's "**irrelevant**" argument is a clear deficiency in the purported *prima facie* case of anticipation in support of the Examiner's rejection. In addition, Appellants respectfully request that the Panel withdraw the rejections and that Claims 1-13 and 27-33 be allowed.

III. **GARDNER FAILS TO ANTICIPATE CLAIMS 1-13 AND 27-33**

Claims 1-13 and 27-33 stand rejected under 35 U.S.C. § 102(b) over *Gardner*. Appellants respectfully submit that *Gardner* fails to disclose each and every limitation recited by Claims 1-13 and 27-33. Appellants respectfully submit that the Examiner's final rejection is clearly not proper because *inter alia* the Examiner provides no concise explanation as how *Gardner* is considered to anticipate all of the limitations in Claims 1-13 and 27-33. (e.g., see 10 August 2006 Response, Pages 15-17). ***A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if each and every element of a claimed invention is identically shown in that single reference.*** MPEP § 2131. (Emphasis Added).

The Examiner's final rejection under 35 U.S.C. § 102 is ***a clear deficiency in the purported prima facie case of anticipation*** because *inter alia*, the Examiner has not shown how each and every element of Appellants claimed invention is identically shown in *Gardner*. For example, the Examiner asserts that "the system of *Gardner* ***indeed includes*** using at least one customer-specified rule identifying a sourcing constraint in determining which supplier to use". (21 June 2006 Final Office Action, Page 7). Appellants respectfully disagree and specifically address the Examiner's ***clear deficiency in the purported prima facie case of anticipation in support of the Examiner's rejection.*** (e.g., see 10 August 2006 Response, Page 15). In another example, the Examiner asserts that "the system of *Gardner* ***indeed includes*** receiving quotes that comprise availability information". (21 June 2006 Final Office Action, Page 7). Appellants respectfully disagree and specifically address the Examiner's ***clear deficiency in the purported prima facie case of anticipation in support of the Examiner's rejection.*** (e.g., see 10 August 2006 Response, Pages 16-17). In still another example, the Examiner asserts that "the system of *Gardner* ***indeed includes*** generating a quotation that includes the contract value". (21 June 2006 Final Office Action, Page 8). Appellants respectfully disagree and specifically address the Examiner's ***clear deficiency in the purported prima facie case of anticipation in support of the Examiner's rejection.*** (e.g., see 10 August 2006 Response, Page 17).


In addition, Appellants respectfully submit that *the Examiner has not set forth the relevant teachings of Gardner* including any references to the relevant column and line numbers of *Gardner* or asserted any argument or remarks regarding how each and every element of the Appellants claimed invention is identically shown in *Gardner*. The Appellants respectfully point out that "it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." Ex parte Levy, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990). Accordingly, *the Final Office Action has failed to establish a prima facie case of anticipation in Claims 1-13 and 27-33 under 35 U.S.C. § 102 with respect to Gardner because Gardner fails to identically disclose each and every element of the Appellants claimed invention, arranged as they are in Appellants claims.* Therefore, Appellants respectfully request that the Panel withdraw the rejections and that Claims 1-13 and 27-33 be allowed.

IV. Conclusion:

Appellants respectfully submit that the finality of the Final Office Action mailed 21 June 2006 is clearly improper and without basis. Appellants further respectfully submit that the Examiner's final rejection is clearly not proper because the Examiner has clearly failed to state a *prima facie* anticipation rejection of Appellants Claims 1-13 and 27-33. Accordingly, Appellants respectfully request that the Panel withdraw the rejections and issue a Notice of Allowance of Appellants Claims 1-13 and 27-33. The Panel is invited to call the undersigned, Steven J. Laureanti, if in the opinion of the Panel such a telephone conference would expedite or aid the prosecution and examination of the subject Application.

Respectfully submitted,

9/18/06
Date


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